

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Jonathan O'Toole et al.
U.S. Patent No.: 11,413,380 Attorney Docket No.: 58498-0003IP2
Issue Date: August 16, 2022
Appl. Serial No.: 17/203,327
Filing Date: March 16, 2021
Title: BREAST PUMP SYSTEM

Mail Stop Patent Board

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PETITIONER'S NOTICE RANKING AND EXPLAINING
MATERIAL DIFFERENCES BETWEEN PETITIONS FOR *INTER*
***PARTES* REVIEW OF U.S. PATENT**
NO. 11,413,380

Petitioner filed a “parallel petition” (IPR2024-01296) after a first petition was recently filed in case no. IPR2024-00953, challenging all claims of U.S. Patent No. 11,413,380 (“the ’380 patent”). Pursuant to the Consolidated Trial Practice Guide (2019), Petitioner submits this paper to identify: (1) a “ranking of the Petitions” and (2) a “succinct explanation of the differences” between the petitions. *See* CTPG, 59-60. Here, Petitioner ranks the parallel petition (IPR2024-01296) as a higher priority. Indeed, Petitioner even requested that the first petition (IPR2024-00953) be dismissed only a few weeks after the Notice According a Filing Date in a good faith effort to reduce any potential burden upon the Board (e.g., by eliminating the need for two institution decisions). *CSC Serviceworks, Inc. v. Payrange Inc.*, IPR2023-01449, Pap. 14, 11 (PTAB Apr. 12, 2024) (“was not evaluated on the merits”). The request to dismiss remains pending.

I. Ranking of Petitions

Although Petitioner believes that both Petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Petition	Primary Ground (against Independent Claims)
1	IPR2024-01296	Chang in view of Fang and Yuen
2	IPR2024-00953	Chang in view of Weber and Guthrie

As explained in detail below, Petitioner ranks the parallel petition (IPR2024-01296) as a higher priority due to the pertinence of the Fang publication, which highlights the examiner’s mistaken belief regarding the state of the art when the

'380 patent was allowed. *See* IPR2024-01296, Petition, Section IV.B.

Additionally, Petitioner was unaware of the Fang publication until after the first petition was already filed. In the concurrent litigation, Patent Owner's initial infringement contentions were served on June 10, 2024—only after the first petition was filed—which were then updated on August 1, 2024. *See* IPR2024-01296, EX1026, 3-5; EX1027, 11-12 (“to prepare invalidity contentions”). In view of these recent revelations regarding Patent Owner's view of the claim scope, Petitioner began its subsequent work on the invalidity contentions. *Id.* During this time, Petitioner uncovered the Fang reference (a Chinese publication) and then obtained a certified translation of Fang, thereby highlighting for the first time Fang's pertinence to the examiner's mistaken belief when allowing the '380 patent.

II. Factors Supporting Institution, Including Material Differences

As an initial matter, the two petitions here are “parallel petitions,” filed before any POPR and before any institution decision, and thus do not impart prejudice to Patent Owner. *Apple Inc. v. Sonrai Memory Ltd.*, IPR2023-00975, Pap. 9, 13-14 (PTAB Dec. 14, 2023) (“the petitions [] are parallel petitions—not serial petitions. CTPG, 59. Thus, Patent Owner's *General Plastic* analysis is inapposite”). Petitioner has not seen a preliminary response or institution decision in the first petition, so “[t]hese circumstances do not implicate the roadmapping concerns that *General Plastic* seeks to alleviate.” *Peloton Interactive, Inc. v. NEC*

Corp., IPR2023-01241, Pap. 17, 16-17 (PTAB Feb. 7, 2024)). Indeed, multiple petitions are reasonable in view of the volume of claims, including 43 asserted claims. Notably, more than half of the claims were newly asserted on August 1, 2024—well after the first petition. *Id.* (“needed to address the volume of claims”); CTPG, 65 (“patent owner has asserted a large number of claims in litigation”).

And, as noted above, Petitioner only recently uncovered the pertinent Fang publication during Petitioner’s subsequent work on the invalidity contentions (*see* EX1027, 12 (“to prepare invalidity contentions”)). This pertinent prior art teaching highlights the examiner’s mistaken reasoning for allowing the ’380 patent. Petitioner acted with extreme diligence. Less than a few weeks after uncovering this new art and obtaining a certified translation, Petitioner rapidly filed this parallel petition to highlight to the Board this new and more meaningful prior art. Critically, all of this was accomplished before any POPR in the first proceeding (IPR2024-00953) to thereby dispel any “roadmap” concerns.

Next, material differences exist between the petitions, which are non-redundant at least in their reliance on different secondary references that demonstrate the known options for conventional modifications to Chang’s device. For example, **IPR2024-00953** relies on Chang combined with Weber and Guthrie. Weber discloses a first type of diaphragm configuration known for use breast pump devices at the time (like Chang), and IPR2024-00953 sets forth reasons why

Chang, Weber, and Guthrie would have been combined to address features of the '380 patent. In contrast, **IPR2024-01296** relies on Chang in combination with the newly-identified Fang reference and Yuen. Fang not only suggests the use of a second type of diaphragm configuration that is highly similar to the preferred embodiment of the '380 patent, but Fang notably illustrated the exact features the Examiner mistakenly believed to be missing from the prior art. While the grounds in both petitions disclose each element of the challenged claims, these distinct secondary references disclose the claimed features, and combine with Chang, in materially different ways. The ability to completely address the Challenged Claims with meaningfully different references is not a reason to discretionarily deny one of the petitions. Instead, it highlights the asserted breadth of the Challenged Claims and the appropriateness of two petitions.

Finally, it should be recognized that Petitioner has purposefully used the Chang primary reference for common elements in the two petitions, thereby streamlining review by the Board and Patent Owner. *Peloton*, IPR2023-01241, Pap. 17, 17 (“Concerns about the burden on the Board and on [Patent Owner] are mitigated by the similarity between the two petitions”). For at least this reason, Petitioner would not oppose consolidating the two proceedings under 35 U.S.C. § 315(d), which would streamline briefing, motion practice, and hearings. *Id.*

Dated August 14, 2024

(Control No. IPR2024-01296)

/Michael T. Hawkins/

Michael T. Hawkins, Reg. No. 57,867

Fish & Richardson P.C.

Attorney for Petitioner